



Paper No. 39

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OFFICE OF PETITIONS

In re Application of :
Dovek et al. :
Application No. 09/067,795 : ON PETITION
Filed: April 28, 1998 :
For: FLUX-GUIDED :
MAGNETORESTRICTIVE HEAD USING A :
PERPENDICULAR RECORDING MEDIA :
:

This is a decision on the petition filed January 26, 2004, requesting that the response filed on April 1 (sic, 7), 2003, be entered.

The petition is **dismissed**.

Petitioner presents an alternative petition under 37 CFR 1.182 after receiving the adverse decision mailed January 14, 2004 by the Group Director on his petition filed under 37 CFR 1.181, likewise seeking entry of the amendment filed April 7, 2003.

In brief, the appeal of the final rejection(s) of claims 1 through 60 was affirmed in part by the Board of Patent Appeals and Interferences ("BPAI") in that the rejection(s) of claims 1-4, 6, 7, 13-15, 17-19, 21, 24-27, 29-34, 42-48, 50, 53, 57, 58 and 60 was affirmed, and the rejection(s) of claims 5, 8, 9, 10, 12, 16, 20, 22, 23, 28, 35-41, 49, 51, 52, 54, 55, 56, and 59 was reversed. On April 7, 2003 applicants filed an amendment that (1) added the limitations of dependent claims 5, 20, and 36 to respectively, independent claims 1, 17, and 30, (2) canceled claims 5, 20, and 36, and (3) presented new claims 61 through 83, which respectively, were claims 8, 9, 10, 12, 16, 22, 28, 35, 38, 39, 40, 41, 49, and 51, rewritten to depend on the now amended independent claims 1, 17, and 30.

On August 14, 2003, an Advisory Action was mailed which refused entry of the aforementioned amendment on the grounds that prosecution remained closed and the amendment proposed new claims without canceling a corresponding number of finally rejected claims. The examiner cited 37 CFR 1.116(c) and § 1.198.

On August 21, 2003, applicants filed a petition under 37 CFR 1.181, seeking review of the examiner's refusal to enter the aforementioned amendment. The petition quoted 37 CFR 1.116(c) and § 1.198, noted that neither rule required that an amendment presenting new claims cancel a like number of finally rejected claims as a condition of entry, and further urged that the claims herein were not finally rejected.

The petition was denied in the Group Director's decision of January 14, 2004. The decision relied upon MPEP 1214.06 in noting that prosecution in this application remained closed except as to matters reversed in the BPAI decision, that had the aforementioned reply merely added claims 61 through 83, such would have been acceptable but incorporation of the subject matter of claims 5, 20 and 36 into claims 1, 17, and 30 respectively altered the scope of the remaining claims, such that further prosecution would be entailed.

In the instant petition, petitioner agrees with the Group Director's reliance on MPEP §1214.06, but notes that the Group Director did not address MPEP 1214.07, which petitioner considers controlling. Petitioner asserts that the petition seeks to avoid a "rehash" of the issues before the Group Director, and as such the relief is requested under 37 CFR 1.182 rather than under § 1.181. Petitioner contends that the reply filed April 7, 2003, obviously places the instant application in condition for allowance, and as such, the amendment should be entered, per MPEP 1214.07. Lastly, petitioner contends that the application is not under final rejection, and as such, the refusal to enter the amendment is improper.

Taking the last issue first, while applicant is technically correct in asserting that this application is not currently under a final rejection, insofar as the treatment of the amendment filed April 7, 2003, is concerned, this application is nevertheless closed to further prosecution in the same manner as any application which has been subjected to a final rejection. That is, the Notice of Appeal filed October 10, 2000, has the same force and effect with respect to the treatment of any amendment filed thereafter as if a final Office action had been mailed October 10, 2000. See 37 CFR 1.116(c) ("if amendments touching the merits of the application...are presented after final rejection, *or appeal has been taken*...they may be admitted upon a showing of good and sufficient reasons...(emphasis added).") It follows that the mailing of the Advisory Action on August 14, 2003, was entirely consistent with the status of this case being closed to further prosecution in the same manner that an Advisory Action is mailed to advise the applicant of an unsuccessful amendment filed in an application that is under final rejection. Thus, it is of no moment to the treatment of amendments filed after October 10, 2000, as to whether a final Office action had been mailed, or, as here, a Notice of Appeal had been filed: applicant was no longer able to amend this application as a matter of right. See 37 CFR 1.116(c).

Petitioner's contention that the amendment filed April 7, 2003, is in conformity with 37 CFR 1.196(c) is not understood but, in any event, is immaterial. Inspection of the BPAI decision of March 26, 2003, fails to reveal an explicit statement by the BPAI that any claim herein would be allowable in amended form. The making of a statement under 37 CFR 1.196(c) is discretionary with the Board. In the absence of an express statement, a remark by the Board that a certain feature does not appear in a claim is not to be taken as a statement that the claim may be allowed if the feature is supplied by amendment. Ex parte Norlund, 1913 C.D. 161, 192 O.G. 989 (Comm'r Pat. 1913). Accordingly, since the BPAI has not made an explicit statement within the meaning of 37 CFR 1.196(c), it is not seen how the amendment of April 7, 2003, can be asserted to be in compliance with that regulation.

Petitioner contends that MPEP 1214.07 is controlling as "the Response filed on April [7], 2003, obviously and unquestionably places the captioned application in condition for allowance." MPEP 1214.07 does speak to the treatment of, as here, an unsolicited amendment filed after a BPAI decision, which is an attempt to reopen prosecution under 37 CFR 1.198. It seems to be the logic of petitioner that since independent claims 1, 17, and 30 were amended to contain the subject matter of, respectively,

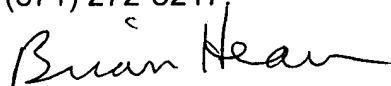
former dependent claims 5, 20, and 36,, whose prior art rejections were reversed by the BAI, it ineluctably follows that any claim dependent on new claims 1, 17, and 30 was necessarily allowable as well. However the BPAI never considered the patentability of such newly presented claims under 35 U.S.C. §§ 101, 112, etc; the BPAI only considered the patentability of claims 5, 20, and 30 insofar as they depended on claims 1, 17, and 30 and then only insofar as 35 U.S.C. § 102 and § 103 over the applied prior art references. That is, no tribunal of the USPTO has yet suggested that all of the claims proposed by the amendment of April 7, 2003, are patentable; it is solely petitioner's unsubstantiated allegation that the proffered claims "obviously" are all allowable.

It is well settled that the USPTO will not reopen prosecution after a decision by the BPAI merely upon the suggestion of the applicant that proposed claims are allowable. See Ex Parte Bourne, 1904 Dec. Comm'r Pat. 247 (Comm'r Pat. 1904)(reopening refused where applicant suggests that proposed claims are patentable but where no tribunal of the USPTO has ever suggested that the proposed claims would be allowable). Rather, applicant is not entitled to demand consideration of new claims after appeal since the question of patentability cannot be determined without reexamination. Id.

It follows that the requested reopening of prosecution would not be proper herein within the meaning of 37 CFR 1.198, as the proposed claims do not "obviously" place this application in condition for allowance. Nevertheless as noted in MPEP 1214.07, applicant may have the proposed claims considered by the examiner, if applicant should request reopening of prosecution by way of filing an RCE under 37 CFR 1.114. Since 37 CFR 1.198 governs the question of reopening of prosecution in the absence of an RCE, and 37 CFR 1.114 provides a mechanism for the requested reopening of prosecution where such is not proper within the meaning of 37 CFR 1.198, 37 CFR 1.182 is inapposite. 37 CFR 1.182 is not a mechanism for avoiding the requirements of the established rules and procedures. See Hicks v. Costello, 1903 Dec. Comm'r Pat. 123, 125 (Comm'r Pat. 1903).

This application is being forwarded to Technology Center 2600.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3217.



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Patent Examination Policy